

REMARKS

I. Claim Amendment

Claim 1 is amended to better claim the disclosed subject matter. No new matter is added. See, for example, the specification at page 8, line 5 (describing filter as attached “on fuel cell 30”).

II. Claim Rejections

Claims 1-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 02/22234 in view of Applicants’ Specification as evidenced by Donaldson Product Guidelines and Specification. Claims 15-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Herdeg et al. (U.S. Patent No. 6,403,243) in view of Applicants’ Specification.

A. Applicants’ Specification is Not Prior Art Against Itself

Applicants respectfully submit that the specification of the present application does not constitute prior art against itself. The Examiner rejected each of the pending claims as obvious over other references in combination with the Applicants’ own specification. However, it is basic that an inventor’s application cannot serve as prior art against itself. Rather, a prior disclosure must at the very least precede the application priority date to constitute prior art. See 35 U.S.C. § 102. Of course, the application itself does not precede its own filing date, and as such, the disclosure in the application does not constitute prior art against itself. See also MPEP 2145(X)(A) (stating that an obviousness analysis can only account for ordinary skill at the time the invention was made and does not include knowledge from the applicant’s disclosure); MPEP

§ 2129 (stating that the work of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories).

Because each of the rejections is improperly based on the applicants' own specification and the teachings therein, the rejections are improper and should be withdrawn.

B. There is No Suggestion or Motivation to Combine References

Applicants' specification teaches that certain filter structures previously commercially available for use with computer disk drives can be adapted and configured for performing separate functions with a fuel cell. This inventive step is nowhere disclosed or suggested in the prior art, but rather is only taught in Applicants' own specification. It would not have been obvious to a person of skill in the art, prior to Applicants' disclosure, to have made the combinations disclosed in Applicants' specification. More particularly, the filters referenced in Applicants' specification are configured for use in computer disk drives. The description of the filters provided in the Donaldson Product Guidelines & Specifications is directed toward unique aspects of the application to a computer disk drive, such as instructions on locating the filter "on the cover as close as possible to the spindle." This description would not teach or suggest to a person of skill in the art of fuel cells the application or configuration of the filter for use with a portable fuel cell. Because there is no showing that a person of skill in the art would make the combination, nor is there a suggestion in the references to make the combination, Applicants' respectfully submit that the pending claims are not obvious over the prior art of record.

C. All Claim Limitations Are Not Disclosed in the Prior Art

The present invention is directed to portable fuel cells and filters for mobile electronics such as cell phones and personal computing devices. The prior art references do not disclose certain limitations present in the pending claims that are meaningful in the context of portable devices. For example, claim 1 requires, among other limitations, a “filter assembly constructed and configured in or on the fuel cell.” This limitation is not disclosed in reference WO 02/22234. See Figure 1 (showing housing 11 as separate from fuel cell 102). Furthermore, claim 15 requires “methanol contained in a compartment having a vent . . . [and] a filter assembly positioned within the vent.” The reference 6,403,243 does not disclose a filter assembly positioned within a vent of a methanol compartment. Rather, as is apparent from Figure 1, filter 30 is positioned away from tank 20, with intervening line 21 and valve 23. Likewise, the Donaldson Product Guidelines & Specifications disclose only filters for computer disk drives, and hence do not disclose any of these limitations either. Because at least these certain limitations are neither present in the prior art references nor suggested therein, Applicants respectfully submit that the claims are patentable over these references.

SUMMARY

In view of the foregoing remarks, Applicants respectfully request reconsideration and allowance of the claims. Early notice of allowability is kindly requested.

The Examiner is respectfully requested to contact the undersigned by telephone at 612.746.4783 or by E-mail at dpauly@pdsdlaw.com with any questions or comments.

Please grant any extension of time, if necessary for entry of this paper, and charge any fee due for such extension or any other fee required in connection with this paper to Deposit

Account No. 50-3688.

Respectfully submitted,

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